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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,298	04/17/2007	Jaime Gosalvez Berenguer	U 016409-0	4147
140	7590	11/30/2009		
LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023			EXAMINER CHUNDURU, SURYAPRABHA	
			ART UNIT	PAPER NUMBER
			1637	
			NOTIFICATION DATE	DELIVERY MODE
			11/30/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyuspatactions@ladas.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,298	<b>Applicant(s)</b> GOSALVEZ BERENGUER ET AL.	
	<b>Examiner</b> Suryaprabha Chunduru	<b>Art Unit</b> 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 18 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18, 20, 21 and 24-27, 29 is/are rejected.
- 7) ☒ Claim(s) 22, 23, 28 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. The Applicants' response to the office action filed on July 29, 2009 has been considered and acknowledged.

***Status of the Application***

2. Claims 18, 20-30 are pending under examination. Claim 19 is cancelled. Claims 31-34 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group. All arguments and the amendment were fully considered and deemed persuasive in-part for the reasons that follow. The action is made FINAL.

***Response to Arguments:***

3. With regard to the objection to the specification, Applicants' arguments and the amendment were fully considered and found persuasive. The objection is withdrawn herein in view of the amendment.

4. Submission of English translation of the foreign priority document has been fully considered and acknowledged.

5. With regard to the rejection of claims 18-21, and 27, 29 as being anticipated by Spano et al. Applicants' arguments were fully considered and found unpersuasive. Applicants argue that Spano et al. teach only a denaturing step and does not teach lysis step. The arguments were found unpersuasive. First, Spano et al. teach a denaturing solution that includes a lysis step, which is within the scope of the instant claims, since the lysis solution according to the instant claim 18 recites that the lysis solution does not comprise protein denaturing detergents. Further, the dependent claims 20-21 recite that the lysis solution comprises a non-ionic non protein detergent (Triton X-100), claim 24 recites that the denaturing solution is an acid solution (HCl) and Spano et al. does teach said

limitations. Second, the instant claims as presented do not recite any limitations of the denaturing and lysis solutions other than the limitations as discussed above, that would distinguish between those two solutions and the broader scope of the claims does not exclude the limitations taught by Spano et al. Applicants also argue that Spano et al. does not teach measuring halo size and the arguments were found unpersuasive because the staining step taught by Spano et al. and the flow cytometry analysis of sperm structure based on the accumulation of single stranded DNA versus double stranded DNA in sperm cells stained with fluorescence green or acridine orange does measure the chromatin size or structure. Accordingly the instant claims are anticipated.

6. With regard to the rejection of claims 18-21, 24-27, and 29 as being anticipated by Januskaukas et al., Applicants' arguments were fully considered and found unpersuasive. As discussed above in the context of Spano et al., the instant claims do not distinguish denaturing and lysis solution, and the broader scope of the claims do not exclude the limitations as taught by Januskaukas et al. since the acid denaturing solution taught by Januskaukas et al. does include lysis solution. Further, Januskaukas et al. does teach measuring chromatin structure based on sperm chromatin structure assay as discussed in the rejection. Accordingly the claims are anticipated.

7. With regard to the rejection of claims 18, 20-23, 27-30 under 35 USC 102(b) as being anticipated by Connell et al., Applicants' arguments and the submission of English translation of the foreign priority document were fully considered and found persuasive. The rejection is withdrawn herein in view of the English translation of the foreign priority document.

*Allowable Subject Matter*

8. Claims 22-23, 28, 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Suryaprabha Chunduru/

Primary Examiner, Art Unit 1637